



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/402,702	10/06/1999	DOMINIQUE CAZIN	511/96506.01	6300

7590 01/23/2004

EUGENE C. RZUCIDLO ESQ  
GREENBERG TRAURIG LLP  
885 THIRD AVENUE  
21ST FLOOR  
NEW YORK, NY 10022

EXAMINER

POKRZYWA, JOSEPH R

ART UNIT	PAPER NUMBER
----------	--------------

2622

DATE MAILED: 01/23/2004

15

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/402,702

Applicant(s)

CAZIN, DOMINIQUE

Examiner

Joseph R. Pokrzywa

Art Unit

2622

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 29 December 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.Claim(s) objected to: none.Claim(s) rejected: 1 and 3-7.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Period for Reply*

1. The period for reply was extended to run 4 MONTHS from the date of the final rejection. Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a) accompanied by the appropriate fee. The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. A reply within the meaning of 37 CFR 1.113 or a request for a continued examination (RCE) in compliance with 37 CFR 1.114 must be timely filed to avoid abandonment of this application.

### *Response to Amendment*

2. The amendment filed 12/29/03 under 37 CFR 1.116 in reply to the final rejection will be entered upon the filing of an appeal, but is not deemed to place the application in condition for allowance. Upon the filing of an appeal and entry of the amendment, the status of the claims would be as follows:

**Allowed claim(s): none**

**Rejected claim(s): 1, and 3-7**

**Claim(s) objected to: none**

***Response to Arguments***

3. Applicant's arguments filed 12/29/03 have been fully considered but they are not persuasive.

In response to applicant's arguments regarding the rejection of **claim 1**, which was cited in the Office action dated 8/26/03 as being anticipated by Rachelson (U.S. Patent Number 6,157,706), the applicant argues on page 5 that Rachelson can not be relevant since it relates to a path between a computer and a fax, thereby failing to teach of an improved fax machine capable of sending Internet faxes by itself, because it includes managing means, which are not taught by Rachelson. First, the examiner notes that the mail processing agent 202, shown in Figs. 2 and 3, can be interpreted as a "fax machine", since it includes a fax board, as read in column 6, lines 1 through 18, and capable of having incoming and outgoing faxes. Further, these features are implemented in a similar fashion to the fax server 200, SMTP server 204, and EPO's 112, 142, 152. Thus, these systems can be considered fax machines. With this, currently claim 1 requires "the fax machines ...characterized by the fact that it has ... means for managing the record, for extracting the electronic addresses and associating them with the corresponding fax machines".

Rachelson teaches that the fax machine (being the agent 202 in Fig. 2, as well as the other similarly implemented devices) includes a call processor that manages the records, extracts electronic addresses, and associates them with corresponding fax machines (read in column 8, lines 4 through 28, and column 13, lines 14 through 38, whereby the processor manages and controls the address book within the system). Continuing, Rachelson teaches of memory means for storing a record of the fax machine communications with corresponding fax machines (column 8, lines 4 through 28, whereby the Address Book is the memory means which stores the

Art Unit: 2622

record of communications, being corresponding dialed numbers and e-mail addresses). Further, Rachelson shows that the fax machines have an electronic mail address on the aforesaid computer network, as read in column 13, lines 28 through 36, wherein the e-mail addresses are inherently “on the aforesaid computer network”. Thus, one of ordinary skill in the art can interpret Rachelson as teaching these limitations.

Continuing, applicant argues on page 6 that Rachelson does not teach the required means for asking a corresponding fax machine for its electronic address, during communication with the corresponding fax machine across the telephone network. The examiner notes that Rachelson teaches of means for asking a corresponding fax machine for its electronic address, during a communication with the aforesaid corresponding fax machine across the telephone network in column 8, lines 10 through 12, wherein “[e]ach time e-mail is received by the user from someone who has previously not sent the user e-mail, the system automatically makes an entry in the address book”, as well as in column 13, lines 14 through 31, wherein the CSID is asked for (during the standard facsimile protocol) and received which is used to determine the e-mail address.

4. Therefore, the rejection of **claim 1**, as well as dependent **claims 3-7**, cited as being anticipated by Rachelson, is maintained.

Art Unit: 2622

***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (703) 305-0146. The examiner can normally be reached on Monday-Friday, 7:30-4:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (703) 305-4712. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.



Joseph R. Pokrzywa  
Examiner  
Art Unit 2622

jrj



EDWARD COLES  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600